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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,555	11/20/2003	David Joseph Preskar	241574US26	5686

22850 7590 06/07/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/716,555	PRESKAR ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anthony Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-14 is/are allowed.
- 6) ☒ Claim(s) 1-5, 15, 16, 21-26 and 29-35 is/are rejected.
- 7) ☒ Claim(s) 17-20, 27 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11202003</u> .  | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-2, 21-22, 29-32 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Lombardino 6,751,891. Lombardino '891 discloses all the limitations of the claims including the following: a sole assembly (see Figure 1); a cushioning arrangement (Figure 2) disposed within the sole assembly (see Figure 1); the cushioning arrangement comprising at least one cushioning element 24, 28; a stiffening spring 50 at least partially surrounding the at least one cushioning element (see Figure 5); the stiffening spring has a stiffness greater than the at least one cushioning element (spring is steel, cushion element is foam); a portion of the cushioning spring is disposed adjacent to a periphery of the shoe and the stiffening spring at least partially defines an aperture (aperture is top interior of spring, cushion is disposed in spring center to hold spring); the at least one cushioning element is disposed in the aperture such that the at least one cushioning element can be seen and touched from an exterior of the shoe (see Figure 1); a sole assembly (see Figure 1); a plurality of cushioning arrangements 28, 24 provided across a width

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of the sole assembly; a first cushioning assembly disposed on a medial side of the shoe (choose any one shown in Figure 11); a second cushioning assembly disposed adjacent the first cushioning assembly (see Figure 11); a third cushioning assembly (see Figure 11); a fourth cushioning assembly disposed such that the third cushioning assembly is disposed between the second and fourth cushioning assemblies (see Figure 11); a fifth cushioning assembly disposed on a lateral side of the shoe (See Figure 11, opposite side of first cushioning assembly); the first and fifth cushioning assemblies each include at least one cushioning element 24, 28, a stiffening spring 50 at least partially surrounding the at least one cushioning element, the stiffening spring has a stiffness greater than the of the at least one cushioning element (steel spring, foam cushion element); the at least one cushioning element comprises a plurality of cushioning elements 24, 28; the cushioning elements have an hourglass shape (24 and 28 are both tapered and when placed upon one another for the hourglass shape); the cushioning elements are formed by inverted truncated cones (24, 28 are tapered cones); the at least one cushioning element is disposed in an aperture defined by the stiffening spring (in top of the spring coil).

3. Claims 1, 21-22, 29-30, 33 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Jacinto 4,592,153. Jacinto '153 discloses all the limitations of the claims including the following: a sole assembly (see Figure 3); a cushioning arrangement 25, 33, 35, 27, 37 disposed within the sole assembly (see Figure 3); the cushioning arrangement comprising at least one cushioning element (25, 33, 35, 27, 37); a stiffening spring 13, 15, 17 at least partially surrounding the at least one cushioning element (see Figure 3); the stiffening spring has a stiffness greater than the at least one cushioning element (stiffness of steel spring is greater than foam or rubber); a portion of the cushioning spring is disposed adjacent to a periphery of the

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shoe (See Figure 3) and the stiffening spring at least partially defines an aperture (side portions of the spring); the at least one cushioning element is disposed in the aperture such that the at least one cushioning element can be seen and touched from an exterior of the shoe (see Figure 3); a sole assembly (see Figure 3); a plurality of cushioning arrangements 25, 33, 35, 27, 37 provided across a width of the sole assembly; a first cushioning assembly 25 disposed on a medial side of the shoe; a second cushioning assembly 37 disposed adjacent the first cushioning assembly; a third cushioning assembly 35; a fourth cushioning assembly 37 disposed such that the third cushioning assembly is disposed between the second and fourth cushioning assemblies; a fifth cushioning assembly 27 disposed on a lateral side of the shoe; the first and fifth cushioning assemblies each include at least one cushioning element 25, 27, a stiffening spring 13, 15, 17 at least partially surrounding the at least one cushioning element (see Figure 3), the stiffening spring has a stiffness greater than the of the at least one cushioning element (steel stiffer than foam or rubber); the at least one cushioning element comprises a plurality of cushioning elements 25, 33, 35, 27, 37; the stiffening spring surrounds the plurality of cushioning elements (see Figure 3); the at least one cushioning element is disposed in an aperture defined by the stiffening spring (see Figure 3).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacinto 4,592,153 as applied to claim 1 above in view of Lombardino 6,751,891. Jacinto '153 as applied to claim 1 above discloses all the limitations substantially as claimed including a first plurality of cushioning elements 35, 27 disposed in the aperture (see Figure 3) a space is provided between adjacent ones of the first plurality of cushioning elements (see Figure 3, space is 37); and a second plurality of cushioning elements 25, 33 provided wherein the second plurality of cushioning elements are disposed behind the first plurality of cushioning elements with respect to a viewing direction from an exterior of the shoe and through the aperture (see Figure 3). Jacinto '153 does not disclose for a portion of the cushioning spring is disposed adjacent to a periphery of the shoe and the stiffening spring at least partially defines an aperture; the at least one cushioning element is disposed in the aperture such that the at least one cushioning element can be seen and touched from an exterior of the shoe. Lombardino '891 teaches that a portion of the cushioning spring is disposed adjacent to a periphery of the shoe and the stiffening spring at least partially defines an aperture; the at least one cushioning element is disposed in the aperture such that the at least one cushioning element can be seen and touched from an exterior of the shoe as shown in Figure 1. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the cushion elements accessible from the exterior of the shoe sole to allow for easy access to adjust the cushioning to the user's desire.

6. Claims 15-16, 23-26 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacinto 4,592,153 as applied to claims 1, 22 and 33 above in view of Preman et al. 5,224,280. Jacinto '153 as applied to claims 1, 22 and 33 above discloses all the limitations of the claims including the first and fifth cushioning elements having substantially similar

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stiffnesses (see col. 3, line 44-col. 4, line 16), the second and fourth cushioning assemblies having substantially similar stiffness which is less than that of the first and fifth cushioning assemblies (see col. 5, lines 34-52) and the second and fourth cushioning assemblies are staggered (see Figure 3). Jacinto '153 does not disclose the stiffening spring having a curved top disposed above at least one cushioning element. Preman et al. '280 teaches that the top wall 13 of a stiffening spring 4 can be curve to help in absorbing the impact of a user's foot with the ground. Therefore, it would have been obvious to make the top wall of the stiffening spring of Jacinto '153 curved to aid in cushioning the impact of the user's foot with the ground.

#### ***Allowable Subject Matter***

7. Claims 6-14 are allowed over the prior art of record.
8. Claims 17-20 and 27-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

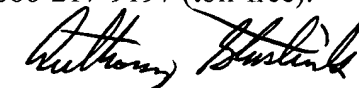
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Anthony Stashick", is positioned above the printed name.

Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS